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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/736,532	12/11/2000	Daniel J. Shoff	MS1-089USC2	8374

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EXAMINER	
SALCE, JASON P	

ART UNIT	PAPER NUMBER
2611	8

DATE MAILED: 05/11/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	09/736,532	SHOFF ET AL.	
	Examiner	Art Unit	
	Jason P Salce	2611	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) 56-69 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) 56-69 is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☒ The drawing(s) filed on 11 December 2000 is/are: a)☒ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date 4-7.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Double Patenting

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claims 56, 60, 66 and 68 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 4 of U.S. Patent No. 6,240,555. Although the conflicting claims are not identical, they are not patentably distinct from each other because independent claims 56, 66 and 68 of the instant application is anticipated by patent '555 claim 4 in that claim 4 of the '555 patent contains all the limitations of claims 55, 66 and 68 of the instant application. Claims 55, 66 and 68 of the instant application therefore is not patentably distinct from the earlier '555 patent claim 4 and as such is unpatentable for obvious-type double patenting (see In re Goodman (CA FC) 29 USPQ2d 2010 (12/3/1993)).

Referring to claim 60, claim 4 of the '555 patent also discloses transmitting the digital data and the video content as two separate signals.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

> A person shall be entitled to a patent unless –
>
> (e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

1. Claims 56-59 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Hidary et al. (U.S. Patent No. 5,778,181).

Referring to claim 56, Hidary discloses configuring digital data (URL transmitted in the VBI at Column 3, Lines 55-58) which defines a display layout prescribing how the supplemental hyperlink content (Web pages) and the video content program video programming) are to appear in relation to one another when displayed (see Column 5, Line 1 and Column 6, Lines 1-9).

Hidary also discloses transmitting the digital data and the video content program to a viewer-computing unit (see Column 3, Lines 55-58 and Column 4, Lines 12-17).

Hidary also discloses displaying the supplemental hyperlink content and the video content program according to the display layout (see Column 6, Lines 9-11).

Referring to claim 57, Hidary discloses configuring the data to define multiple different display layouts that are selectively displayed to the viewer depending upon the viewer's selections of possible choices presented in the supplemental hyperlink content (see Column 5, Lines 16-33).

Hidary discloses dynamically changing the display layouts of the supplemental hyperlink content and the video content program in response to said viewer's selections (see Column 5, Lines 48-55).

Referring to claim 58, Hidary discloses transmitting the digital data along with the video content program as the same signal (see Column 3, Lines 46-50 and Lines 55-58).

Referring to claim 59, Hidary discloses receiving said signal containing the digital data and the video content program at the viewer-computing unit (see Column 4, Lines 37-40).

Hidary also discloses separating the digital data from the video content program at the viewer-computing unit (see Column 4, Lines 40-43).

Referring to claims 66-67, see rejection of claims 56-57, respectively.

2. Claims 56-59 and 66-68 are rejected under 35 U.S.C. 102(e) as being clearly anticipated by Dougherty et al. (U.S. Patent No. 5,848,352).

Referring to claim 56, Dougherty discloses configuring digital data, which defines a display layout prescribing how the supplemental hyperlink content and the video content are to appear in relation to one another when displayed (see Figures 7A and 7B and Column 14, Lines 15-37 for the Object Definitions describing how the content is displayed in relation to the video and Column 7, Lines 5-10 for the creation of such data).

Dougherty also discloses transmitting the digital data and the video content program to a viewer-computing unit (see Column 7, Lines 23-32).

Dougherty also discloses displaying the supplemental hyperlink content and the video content program according to the display layout (see Figure 1).

Referring to claim 57, Dougherty discloses configuring the data to define multiple different display layouts that are selectively displayed to the viewer depending upon the viewer's selections of possible choices presented in the supplemental hyperlink content (see Column 19, Lines 19-27 and Lines 40-46).

Dougherty also discloses dynamically changing the display layouts of the supplemental hyperlink content and the video content program in response to said viewer's selections (see Column 21, Lines 11-38 for using scripts to dynamically change the layout).

Referring to claim 58, Dougherty discloses transmitting the digital data along with the video content program as the same signal (see Column 7, Lines 60-62).

Referring to claim 59, Dougherty discloses receiving said signal containing the digital data and the video content program at the viewer-computing unit (see element 234 in Figure 2B and Column 9, Lines 18-19).

Dougherty also discloses separating the digital data from the video content program at the viewer-computing unit (see Column 9, Lines 28-30).

Referring to claim 66, see rejection of claim 56.

Referring to claim 67, see rejection of claim 57.

Referring to claim 68, Dougherty discloses supplemental content for rendering to a viewer, which supplements viewing of a continuous, non-interactive video stream (see Figures 7A, 7B and Figures 8-13).

Dougherty also discloses one or more elements prescribing how the supplemental content is to be rendered along with, and relative to, the video stream (see again Figures 8-13 for objects that are to be displayed with the window displayed along with the video program in Figure 7A).

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

3. Claims 60-65 and 69 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dougherty et al. (U.S. Patent No. 5,848,352) in view of Throckmorton et al. (U.S. Patent No. 5,818,441).

Referring to claim 60, Dougherty discloses all of the limitations in claim 56, but fails to teach transmitting the video content and digital data as two separate signals. Throckmorton discloses transmitting primary and associated data as two separate signals (see Column 4, Lines 15-19). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the transmission medium, as taught by Dougherty, using the two separate transmission mediums, as taught by Throckmorton, for the purpose of avoiding congestion and delays on a transmission network by conserving the bandwidth.

Claim 61 corresponds to claim 56, see rejection of claim 60 for transmitting the associated data and primary data on two different transmission mediums (sources).

Referring to claim 62, Dougherty discloses all of the limitations in claim 56, and also teaches creating a document having extension attributes that assist in defining the display layout (see Figures 8-13 of Dougherty), but fails to teach that this document uses the HTML standard. Throckmorton specifically uses HTML syntax to define the layout of the user interface displayed by a user (see Column 3, Lines 62-67). At the time the invention was made, it would have been obvious to a person of ordinary skill in the art, to modify the data layout data transmitted to the client, as taught by Dougherty, by using the HTML layout data, as taught by Throckmorton, for the purpose of lowing the cost of the system by providing a universal standard format that can be understood by all programmers around the world.

Claim 63 directly relates to claim 62, where Dougherty discloses an Interactive Icon Definition used for specifying a focus extension attribute (see Column 20, Lines 60-65).

Referring to claim 64, see rejection of claim 62.

Claim 65 corresponds to claim 64, where Dougherty discloses a tag to retrieve and display one of the images (see Column 21, Lines 11-38 for a script (tag) that can display an image upon actuation by a user).

Referring to claim 69, see rejection of claims 62 and 64.

Conclusion

4. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jason P Salce whose telephone number is (703) 305-

1824. The examiner can normally be reached on M-Th 8am-6pm (every other Friday off).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Faile can be reached on (703) 305-4380. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

April 19, 2004

VIVEK SRIVASTAVA
PRIMARY EXAMINER